

REMARKS

Claims 1 – 16 have been examined. Claims 11 and 12 have been canceled without prejudice or disclaimer. A typographical error has been corrected in Claim 13.

1. Rejections Under 35 U.S.C. §112

Claims 1 – 10 and 12 stand rejected under 35 U.S.C. §112, ¶2. The rejection of Claim 12 is moot in view of the cancellation of that claim. The rejections of Claims 1 – 10 are respectfully traversed.

The §112 rejection of Claims 1 – 10 is based on the use of the phrase “at least some,” which refers unambiguously to any amount, i.e. more than none. In remarking “(no range, no limitation),” the Office Action appears to object to the breadth of this language, but such an objection is not relevant to a §112 rejection (“Breadth of a claim is not to be equated with indefiniteness,” MPEP 2173.04). Since the language used is precise, even if broad, it is believed that the §112 rejection is improper.

2. Rejections Under 35 U.S.C. §103(a)

Claims 1, 2, 4 – 14, and 16 stand rejected under 35 U.S.C. §103(a) as unpatentable over the document entitled “Privacy at Netbank” (“Netbank”) in view of U.S. Pat. Publ. No. 2003/0018587 (“Althoff”) and Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as unpatentable over Netbank in view of U.S. Pat. No. 5,727,249 (“Pollin”). These rejections are respectfully traversed.

Independent Claim 1 recites, *inter alia*, “storing ... the privacy preference onto the payment instrument,” and Claim 13 recites, *inter alia*, “providing ... a payment instrument having stored thereon a privacy preference.” These limitations are neither

disclosed nor suggested in any of the cited prior art. The Office Action concedes that these limitations are not disclosed in Netbank (Office Action, p. 4, ll. 1 – 2), and relies on Althoff and Pollin for those limitations.

Althoff is directed to a check-out system that may be used to provide the equivalent of “card-present” transactions as part of Internet transactions (Althoff, ¶1). As such, it makes information that is traditionally present on a credit card available to a merchant during an electronic transaction in a verified fashion (*id.*, ¶22). There is no disclosure whatsoever of additionally providing a privacy preference on a payment instrument. The Office Action cites Figs. 1 and 4A, but these figures merely provide flow diagrams respectively indicating how an electronic transaction may be performed without and with the verified credit-card information. Nothing in these figures indicates that the credit card contains anything other than its traditional information, and certainly provide no disclosure of a consumer’s privacy preference.

Pollin is similarly deficient. Pollin is directed to an automated system that generates a draft payable to a payee and drawn on a payor’s checking account (Pollin, Col. 5, l. 66 – Col. 6, l. 3). In producing the draft, MICR ink may be used so that the generated draft may be processed in the banking system in the same fashion as an ordinary check (*id.*, Col. 6, ll. 20 – 22). The Office Action apparently relies on this MICR-ink printing as disclosing storing the privacy preference onto the payment instrument. This reliance is completely misplaced. There is nothing in Pollin to suggest that the MICR-ink information provided on the draft is anything other than the usual information that is printed on checks in MICR ink. Not only is there no disclosure in Pollin of storing the privacy preference onto the payment instrument, there is no discussion at all of privacy concerns.

For these reasons, both independent claims are patentable, and all of the dependent claims are patentable by virtue of their dependence from patentable claims.

Applicant notes that the rejections generally fail to meet the requirements of 37 C.F.R. §1.104(c), which requires designating the particular parts of the references


relied on and clearly explaining the pertinence of each reference. This failure is especially egregious in connection with Pollin, which is cited only in its entirety without identifying any pertinent parts of the reference, but is also true in connection with Althoff where drawings are cited without explaining what elements are supposed to correspond to what is claimed. In the event that any rejection is maintained, Applicant thus requests that the disclosures being relied on be identified with the specificity required by 37 C.F.R. §1.104(c) so that Applicant may consider them fully and respond appropriately.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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